

REMARKS

Claims 26, 27, and 29-45 are presented for consideration. Claims 26, 36-39, and 41 are independent.

Claim 26 has been amended. Support for the amendment can be found throughout the original specification as filed. No new matter has been added.

Applicants respectfully traverse the restriction requirement as set forth in the Office Action, mailed December 8, 2009, in light of the following remarks.

The Office Action contends, on page 2, that Claims 26, 27, 29-37 and 39 are drawn to an “image forming method with plasma processing”, and Claims 38 and 41-45 are drawn to an “image forming method with applying roller, with non-ink absorbing surface.” At least for the following reasons, this contention is respectfully traversed.

First, Applicants respectfully point out that Claims 26, 27, and 30-35 do not recite “plasma processing.” Therefore, the contention that Claims 26, 27, and 30-35 are drawn to an “image forming method with plasma processing” is incorrect.

Second, Applicants respectfully point out that Claims 38 and 41-44, do not recite an “applying roller.” In addition, Claims 38, 41, and 43-45 do not recite a “non-ink absorbing surface.” Therefore, the contention that Claims 38 and 41-45 are drawn to an “image forming method with applying roller, with non-ink absorbing surface” is also incorrect.

Third, the Office Action omits Claim 40 from either group of allegedly distinct inventions.

Accordingly, Applicants submit that the classification of the claims into allegedly distinct inventions, as set forth in the Office Action, is inherently defective.

In addition, the Office Action contends that there would be a serious burden if restriction were not required and sets forth several alleged reasons to support that contention. At least for the following reasons, this contention is also respectfully traversed.

The Office Action, on page 3, states that “there would be a serious search and examination burden if restriction were not required because of one or more of the following reasons.” However, the stated reasons are a mere recitation of possible instances where a serious burden may exist as described in MPEP § 808.02. The Office Action has provided no explanation of why any of those instances apply to the subject application, as required by MPEP § 808.02. (“the examiner must show by appropriate explanation one of the following” MPEP § 808.02). On the contrary, Applicants submit that the prosecution history of this application strongly indicates that no burden exists.

With the exception of the minor amendment shown above, the claims currently pending were previously rejected in the Office Action dated March 19, 2009. Therefore, Applicants submit that the Examiner, having already conducted a search of the prior art, considered the applicability of the prior art, and applied the prior art in the outstanding rejections, would not be seriously burdened by reconsidering those rejections in light of the above amendment, and the Applicants’ remarks contained in the Request for Reconsideration dated September 21, 2009.

Furthermore, because of the Examiner’s familiarity with the subject application and the prior art as a result of previously issuing two Office Actions in the subject application, dated August 21, 2008 and March 19, 2009, Applicants submit that the amount effort required by the U.S. Patent and Trademark Office would be lessened by permitting all of

the claims presently in the application to be prosecuted in a single application. The alternative is to proceed with the filing of an additional application, consisting of the same disclosure, and being subject to substantially the same search, perhaps by a different Examiner on a different occasion, with the resultant burden on the Patent and Trademark Office.

Accordingly, it is respectfully requested that the Examiner reconsider the requirement for restriction and allow the claims as presently in the application to be prosecuted in a single application.

Nevertheless, in order to comply with the requirements of 37 C.F.R. § 1.143, Applicants provisionally elect the claims of Invention I and Group A, namely Claims 26, 27, 29-37, and 39.

Applicants submit that at least for the reasons discussed in the Request for Reconsideration, dated September 21, 2009, the present invention as set forth in the independent claims is patentable over the applied references. Accordingly, reconsideration and withdrawal of the outstanding rejections is respectfully requested. Due consideration and prompt passage to issue are also respectfully requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

/Sean M. Walsh/

Sean M. Walsh
Attorney for Applicants
Registration No. 63,510

FITZPATRICK, CELLA, HARPER & SCINTO
1290 Avenue of the Americas
New York, New York 10104-3801
Facsimile: (212) 218-2200
SMW:ayr

FOHS_WS 4559925v1